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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,469	03/24/2004	Katsuya Miyata	62758-075	2918
7590 09/18/2008 MCDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096				
EXAMINER TAYLOR, JOSHUA D				
ART UNIT 2623		PAPER NUMBER		
MAIL DATE 09/18/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/807,469

Applicant(s)

MIYATA, KATSUYA

Examiner

JOSHUA TAYLOR

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,5,6,15-17 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 3,4,7-14,18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 6/26/2008 have been fully considered but they are not persuasive. Starting on page 8, line 16, and continuing onto page 9, line 8, regarding the rejection of claim 3, applicant argues that caller that "The combination of Tidwell and Chatterjee does not inspire one of ordinary skills to come up with a claimed communication terminal that when an incoming communication arrives from a communication partner in the course of a video reproduction carried out by the terminal, informs the communication partner of an end time of the video reproduction." However, examiner never makes that claim in the Office Action dated 3/26/2008. Examiner had asserted that only with the teachings of Tidwell, Chatterjee and Schein was the invention taught.

On page 10, lines 6-13, regarding the rejection of claim 3, applicant argues that Tidwell does not suggest not disturbing the television viewer in the event of an incoming communication, and therefore teaches away from not disturbing the viewer. However, not teaching something is different from teaching away from it. Secondly, claim 3 does not recite this limitation. Thirdly, in claims containing this limitation, examiner cites Chatterjee as teaching that if the user is busy, the caller is notified and the user is not disturbed (paragraph [0078]).

On page 11, line 21 to page 12, line 9, regarding the rejection of claim 4, applicant argues that "Willame does not teach or suggest informing a communication partner of an end time of a video reproduction when an incoming communication arrives from the communication partner in

the course of the video reproduction, as described in claim 4.” Again, examiner cited Chatterjee and Schein as teaching this limitation.

Applicant’s arguments, see page 9, line 9 to page 10, line 5, filed 6/26/2008, with respect to the Schein reference (Pub. No.: US 2003/0208758) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new grounds of rejection is made in view of Kusaba (Pat. No.: US 6,510,556).

Examiner also suggests that applicant specify what type of communication is occurring when applicant refers to “an incoming communication,” as otherwise this claim language is overly broad.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 7, 9, 11, 18 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Tidwell et al. (US Pat. 6,535,590) in view of Chatterjee et al. (Pub. No.: US 2007/0248221) and Kusaba et al. (Pat. No.: US 6,510,556).

Regarding claim 3, Tidwell discloses **a communication terminal comprising: a video reproduction device configured to carry out a video reproduction** (Tidwell, Fig. 1, column 3, line 66 – column 4, line 7); **a communication device configured to carry out a**

communication (Tidwell, Fig. 1, column 1, lines 38-43). Tidwell does not disclose informing a caller of the end-time of a program a user is watching. However, in analogous art, Kusaba teaches a **reproduction-end-time acquisition device configured to acquire an end time of the video reproduction carried out by said video reproduction device** (Figs. 4C-4F, column 4, lines 7-56. A block of time is reserved for recording a program, meaning that the system acquires the end-time of the program in order to schedule the reserved block). Furthermore, Chatterjee teaches **that in the event of an incoming communication from a communication partner said communication partner is informed** that the user is busy, and informed of a time when the user will be available (Chatterjee, paragraph [0078], lines 1-14). Therefore, since Chatterjee teaches that the caller will be informed as to when the user will be available, and Kusaba teaches that the system knows an end time for the program, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tidwell to include informing a caller of the end-time of a program a user is watching. This would have produced a desirable result, in that the caller would know exactly when the user would become available.

Regarding claim 7, Tidwell discloses **a communication terminal comprising: a TV-broadcast receiving device configured to receive a TV broadcast** (Tidwell, Fig. 1, column 3, line 66 – column 4, line 7); **a display configured to display an image of a TV broadcast received by said TV-broadcast receiving device** (Tidwell, Fig. 1, element 12, column 3, line 66 – column 4, line 7); **a communication device configured to carry out a communication** (Tidwell, Fig. 1, column 2, lines 16-23). Tidwell does not disclose informing a caller of the end-time of a program a user is watching. However, in analogous art, Kusaba teaches a **program-end-time acquisition device configured to acquire an end time of a program of a TV**

broadcast received by said TV-broadcast receiving device (Figs. 4C-4F, column 4, lines 7-56.

A block of time is reserved for recording a program, meaning that the system acquires the end-time of the program in order to schedule the reserved block). Furthermore, Chatterjee teaches **that if an incoming communication arrives from a communication partner, said communication partner is informed** that the user is busy, and informed of a time when the user will be available (Chatterjee, paragraph [0078], lines 1-14). Therefore, since Chatterjee teaches that the caller will be informed as to when the user will be available, and Kusaba teaches that the system knows an end time for the program, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tidwell to include informing a caller of the end-time of a program a user is watching. This would have produced a desirable result, in that the caller would know exactly when the user would become available.

Regarding claims 9 and 11, **the communication terminal according to claims 3 and 7** are rejected as stated above, and further Chatterjee discloses **wherein said communication partner is informed by transmitting a message to said communication partner** (paragraph [0078], lines 1-14. The caller is verbally notified, which is transmitting a message), and Kusaba teaches that **the message can include information on said end time of a video reproduction** (Figs. 4C-4F, column 4, lines 7-56). These claims are rejected on the same grounds as claims 3 and 7, respectively, as claims 3 and 7 imply that a message has been sent.

Regarding claim 18: **A video reproduction method for carrying out a video reproduction** (Tidwell, column 3, line 66 – column 4, line 7) **wherein, in the event of an incoming communication from a communication partner in the course of a video reproduction: an end time of said video reproduction is acquired** (Kusaba, Figs. 4C-4F,

column 4, lines 7-56); **and said communication partner is informed** that the user is busy, and informed of a time when the user will be available (Chatterjee, paragraph [0078], lines 1-14). Therefore, since Chatterjee teaches that the caller will be informed as to when the user will be available, and Kusaba teaches that the system knows an end time for the program, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tidwell to include informing a caller of the end-time of a program a user is watching. This would have produced a desirable result, in that the caller would know exactly when the user would become available.

Claim 20 is rejected on the same grounds as claim 18.

Claims 4, 8, 13 and 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Tidwell et al. (US Pat. 6,535,590) in view of Chatterjee et al. (Pub. No.: US 2007/0248221) and Kusaba et al. (Pat. No.: US 6,510,556), and further in view of Willame et al. (Pub. No.: US 2006/0179462).

Regarding claim 4, Tidwell discloses **a communication terminal comprising: a video reproduction device configured to carry out a video reproduction** (Tidwell, Fig. 1, column 3, line 66 – column 4, line 7); **a communication device configured to carry out a communication** (Tidwell, Fig. 1, column 2, lines 16-23). Tidwell does not disclose informing a caller of the end-time of a program a user is watching, nor does Tidwell disclose having a priority system of programs and callers. However, in analogous art, Kusaba teaches **a reproduction-end-time acquisition device configured to acquire an end time of the video**

reproduction carried out by said video reproduction device (Figs. 4C-4F, column 4, lines 7-56. A block of time is reserved for recording a program, meaning that the system acquires the end-time of the program in order to schedule the reserved block). Furthermore, Willame discloses **a storage device configured to store an incoming-reporting condition indicating whether a video reproduction takes precedence of** over another video reproduction (Willame, paragraphs [0033]-[0034]). Finally, Chatterjee teaches notifying the caller that the user is busy, as well as allowing the user to set the time that the caller is told the user will be available (Chatterjee, paragraph [0078], lines 1-5). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have the decision as to whether to alert the user of an incoming call be based on a comparison of whether the phone call was of higher priority than the video. It also would have been obvious to have the caller notified if the user was busy, and to tell the caller when the user would be available. Allowing the user to program the system in such a manner would have been highly desirable, as it would allow the user to watch television in an uninterrupted manner, unless the user received an urgent phone call of higher priority than the video being watched. Allowing the caller to know that the user is busy and when he will be available would also have been highly desirable, as it would allow the caller to have access to information that would make it easier to get into contact with the user, which is assumed to be the caller's intent.

Claim 8 is rejected on the same grounds as claim 4.

Regarding claim 13, **the communication terminal according to claim 7** is rejected as stated above, and further Willame discloses **wherein: said TV-broadcast receiving is configured to receive a digital broadcast** (Willame, paragraphs [0002], lines 1-10); **and said**

program-end-time acquisition device is configured to acquire an end time of a program of a TV broadcast from information included in broadcasted data of a digital broadcast received by said TV-broadcast receiving device (Willame, paragraphs [0059], lines 1-5). Willame discloses broadcasting television in digital form, as well as transmitting schedule information encoded in the digital broadcast. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to allow for a digital broadcast and that schedule information would be included in the digital broadcast. Because digital television broadcast is positioned to become the new standard in broadcasting, it would have been highly desirable to incorporate it into a TV broadcast receiving communication terminal.

Regarding claim 14, **the communication terminal according to claim 7** is rejected as stated above, and further Willame discloses **wherein said program-end-time acquisition device is configured to acquire an end time of a program of a TV broadcast from information included in a program table distributed by an EPG** (Willame, paragraphs [0059], lines 1-5). Willame discloses receiving program information from an EPG, which inherently includes program end times. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to allow for the program end time to be acquired from an EPG. Because EPGs are commonly used in the art, it would have been highly desirable to incorporate using them as an information source.

Claims 10 and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Tidwell et al. (US Pat. 6,535,590) in view of Chatterjee et al. (Pub. No.: US 2007/0248221) and Kusaba et

al. (Pat. No.: US 6,510,556), and further in view of Buettgenbach et al. (Pub. No.: US 2002/0032613).

Regarding claims 10 and 12, the **communication terminal according to claims 3 and 7 wherein said communication partner is informed of an end time of a video reproduction** is rejected as stated above. Furthermore, in analogous art Buettgenbach discloses the automatic generation of email based on predetermined conditions (Buettgenbach, paragraph [0048], lines 6-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have the caller informed by email that the user was unavailable. Informing the caller by email would have been highly desirable, as it would leave a permanent transaction with which the caller can keep a record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA TAYLOR whose telephone number is (571)270-3755. The examiner can normally be reached on 8am-5pm, M-F, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Josh Taylor/

Examiner, Art Unit 2623

/Vivek Srivastava/

Supervisory Patent Examiner, Art Unit 2623